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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,562	03/23/2004	David L. Marvit	073338.0190 (04-50462 FLA	4041
5073	7590	03/27/2007	EXAMINER	
BAKER BOTTS L.L.P. 2001 ROSS AVENUE SUITE 600 DALLAS, TX 75201-2980			LIANG, REGINA	
			ART UNIT	PAPER NUMBER
			2629	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/27/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/27/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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## Office Action Summary

Application No.

10/807,562

Applicant(s)

MARVIT ET AL.

Examiner

Regina Liang

Art Unit

2629

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2/23/07.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION*****Double Patenting***

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-20 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of copending Application No.

10/807,566. Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 1-20 of this application are broader version of claims 1-21 of copending Application No. 10/807,566.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The following is an example for comparing claim 1 of this application and claim 3 of copending Application No. 10/807,566.

Claim 1 of this application	Claim 3 of copending Application No. 10/807,566
A handheld device comprising:  a display having a viewable surface and  operable to generate an image indicating a  currently controlled remote device;	A handheld device comprising:  a display having a viewable surface and  operable to generate an image indicating the  currently controlled controllable device;
a gesture database maintaining a plurality of  remote command gestures, each remote  command gesture defined by a motion of the  device with respect to a first position of the  handheld device;	a gesture database maintaining a plurality of  gestures, each gesture defined by a motion of  the device with respect to a first position of the  handheld device, the gestures comprising a  plurality of remote command gestures and at  least one device selection gesture;
a gesture mapping database comprising a  mapping of each of the remote command  gestures to an associated command for  controlling operation of the remote device;	a gesture mapping database comprising a  plurality of command maps, each of the  command maps corresponding to a particular  controllable device and mapping at least one of  the remote command gestures to a command  for controlling operation of the particular  controllable device;
a motion detection module operable to detect  motion of the handheld device within three  dimensions and to identify components of the	a motion detection module operable to detect  motion of the handheld device within three  dimensions;

motion in relation to the viewable surface;	
	a device selection module operable to detect the device selection gesture based on the motion of the handheld device and to select a currently controlled one of the controllable devices in response to the device selection gesture;
a control module operable to track movement of the handheld device using the motion detection module, to compare the tracked movement against the remote command gestures to determine a matching gesture, and to identify the one of the commands corresponding to the matching gesture; and	a control module operable to select one of the command maps corresponding to the currently controlled controllable device, to track movement of the handheld device using the motion section module, to compare the tracked movement against the remote command gestures to determine a matching gesture, and to identify, using the selected command map, the command mapped to the matching gesture; and
a wireless interface operable to transmit the identified command to a remote receiver for delivery to the remote device.	a wireless interface operable to transmit the identified command to a remote receiver for delivery to the currently controlled controllable device.

Art Unit: 2629

As can be seen above, claim 1 of this application and claim 3 of copending application are claiming a similar subject matter and claim 1 of this application does not require "a device selection module operable to detect the device selection gesture based on the motion of the handheld device and to select a currently controlled one of the controllable devices in response to the device selection gesture", thus claim 1 of this application is broader version of claim 3 of copending application.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-6, 8-12, 14-18, 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ide et al (US 5,598,187 hereinafter Ide) in view of Ishida (US 2004/0061621).

As to claims 1, 20, Figs. 1-3 of Ide discloses a handheld device (1) comprising: a motion detection module (motion detectors) operable to detect motion of the handheld device within three dimensions, a gesture database (motion pattern memory 42 in Fig. 15) maintaining a plurality of remote command gestures, each remote command gesture defined by a motion of the device with respect to a position of the handheld device (see Figs. 16, 17, and col. 14, lines 7-42); a gesture mapping database comprising a mapping of each of the remote command gestures to an associated command for controlling operation of the remote device (col. 14, lines 39-47); a control module (Fig. 15) operable to track movement of the handheld device using the motion

Art Unit: 2629

detection module (motion detectors 30a, 30b), to compare the tracked movement against the remote command gestures to determine a matching gesture, and to identify the one of the commands corresponding to the matching gesture; and a wireless interface operable to transmit the identified command to a remote receiver for delivery to the remote device(col. 14, lines 7-47 for example).

Ide does not disclose the handheld device comprising a display having a viewable surface and operable to generate an image indicating a currently controlled remote device. However, Fig. 2 of Ishida teaches a remote control device including a display (monitor 17) having a viewable surface and operable to generate an image (lines 5-7 in [0025]). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the handheld device of Ide to have a display as taught by Ishida such that a user can control the device while viewing the built-in monitor ([0013], [0041] of Ishida) and also “sets the operational feel of the rotating wheel to that corresponding to the notebook computer” ([0031] of Ishida; also see [0032, 0036, 0041]) such that the device can be easily controlled while viewing the built-in monitor (see Ishida [0041, 0043, 0046]).

As to claim 2, Fig. 7B of Ide teaches the remote receiver comprises a wireless interface of the remote device.

As to claim 3, Fig. 2 of Ishida teaches the remote receiver comprises an element of a public wireless telephone network (5).

As to claims 4, 5, Ide teaches the identified command of the remote receiver comprises audio/visual equipment (col. 14, lines 14-21).

Art Unit: 2629

As to claim 6, Ide teaches the wireless interface is operable to transmit the matching gesture to the remote receiver for delivery to the remote device (see Fig. 15).

Claims 8-12, 14-18 , which are method claims corresponding to the above apparatus claims 1-5, are rejected for the same reasons as stated above since such method "steps" are clearly read on by the corresponding "means".

5. Claims 7, 13, 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ide and Ishida as applied to claim 1 above, and further in view of Lapidot (WO 01/86920).

Ide as modified by Ishida does not explicitly disclose using first, second and third accelerometers for sensing the motion of the device along a first, second and third axis. However, Fig. 6 of Lapidot teaches using three accelerometers (601-A to 601-C) for sensing the motion of the handheld device along a first, second and third axis. Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the handheld device of Ide as modified by Ishida employ first, second and third accelerometers for sensing the motion of the handheld device along a first, second and third axis as taught by Lapidot since the three accelerometers measure the acceleration of the device along three independent directions precisely.

#### ***Response to Arguments***

6. Applicant's arguments filed 2/14/07 have been fully considered but they are not persuasive.



Applicant's argument in that Ide does not disclose, teach, or suggest "a wireless interface operable to transmit the identified command to a remote receiver for delivery to the remote device", are not persuasive. The motion code indicating the corresponding basic motion pattern is the identified command, and the remote control transmitting circuit 43 and infrared LED 34 are a wireless interface.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). Contrary to applicant's remarks, Ishida clearly provided reasons to combine and provide for a monitor on the remote control device, Ishida teaches that a user can control the device while viewing the build-in monitor ([0013, 0041] of Ishida) and also "sets the operational feel of the rotating wheel to that corresponding to the notebook computer" ([0031] of Ishida; also see [0032, 0036, 0041]) such that the device can be easily controlled while viewing the built-in monitor (see Ishida [0041, 0043, 0046]). Therefore, applicant's remarks are not persuasive.

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

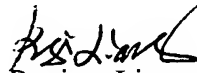
Art Unit: 2629

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Regina Liang whose telephone number is (571) 272-7693. The examiner can normally be reached on Monday-Friday from 8AM to 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (571) 272-7691. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Regina Liang  
Primary Examiner  
Art Unit 2674

3/20/07